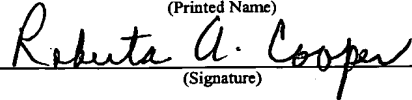05-02-06

Atty. Dkt. No. 035451-0169 (3707.Palm)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Kammer, David

Title: DATA PRIORITIZATION AND DISTRIBUTION LIMITATION SYSTEM AND METHOD

Appl. No.:   10/006,952

Filing Date: 11/5/2001

Examiner: Sams, Matthew C.

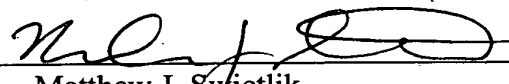Art Unit: 2643

TRANSMITTAL

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Commissioner for Patents
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Sir:

Transmitted herewith are the following documents for the above-identified application.

[X]   Brief On Appeal (24 pages).

[X]   Check for $500.00 for Appeal Fee. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date   _5/1/2006_

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By _Matthew J. Swietlik_

Matthew J. Swietlik
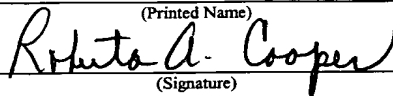Attorney for Applicant
Registration No. 58,428

Application No. 10/006,952

MILW_1995753

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Kammer, David
Title:	DATA PRIORITIZATION AND DISTRIBUTION LIMITATION SYSTEM AND METHOD
Appl. No.:	10/006,952
Filing Date:	11/5/2001
Examiner:	Sams, Matthew C.
Art Unit:	2643

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BRIEF ON APPEAL

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a credit card payment form in the amount of $500.00 covering the 37 C.F.R. § 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1447.

This paper is being filed in response to the final Office Action dated December 1, 2005, finally rejecting claim 1-6 and 8-31. The Notice of Appeal was filed March 1, 2006. Appellants respectfully request favorable reconsideration of the application.

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Application No. 10/006,952

MILW_1986329

1.   **REAL PARTY IN INTEREST**

The real party in interest is the assignee of record, Palm, Inc., as recorded in the records of the United States Patent and Trademark Office at Reel/Frame 012363/0149 on December 5, 2001.

2.   **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellant or Appellant's legal representative

3.   **STATUS OF CLAIMS**

This is an appeal from the final Office Action dated December 1, 2005, finally rejecting claims 1-6 and 8-31. Claims 1-6 and 8-31 are on appeal.

4.   **STATUS OF AMENDMENTS**

Claims 1-6 and 8-31 were pending when a final Office Action dated December 1, 2005 was issued. In response to the final Office Action, and Amendment and Reply dated February 1, 2006 was submitted. In response to the Amendment and Reply, an Advisory Action dated February 26, 2006 was issued, indicating that the Amendment and Reply did not place the application in condition for allowance. No amendments have been filed subsequent to the date of the Advisory Action.

5.   **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 is directed to a method of communicating between a handheld computer (100) and other local area computing devices (200-212) having wireless communication capability. (See Specification, page 6, ¶ [0026]). The method includes providing a handheld computer (100) and identifying a plurality of other local area computing devices (200-212) having wireless communication capability. (See Specification, page 7, ¶ [0028]). The method also includes creating an identifier for one or more of the plurality of other local area computing devices (200-212) (see Specification, pages 7-8, ¶ [0029]) and listing each identifier on a display (114), where the list may be sorted by one or both of

distance and direction from the handheld computer (100). (See Specification, page 8-10, ¶¶ [0030]-[0035]; Figs. 6-7). The method also includes selecting one or more of the listed identifiers and sharing information with the local area computing device (200-212) corresponding to the chosen identifier. (See Specification, pages 7-8, ¶ [0029]).

Independent claim 8 is directed to a method of sharing information between a handheld computer (100) and a group of local area computing devices (200-212) having wireless communication capability. (See Specification, page 6, ¶ [0026]). The method includes specifying a distance and identifying one or more local area computing devices (200-212) having wireless communication capability within the specified distance from the handheld computer (100). (See Specification, page 10, ¶ [0037]). The method also includes listing the computing devices (200-212) on a display (114), where the list is sorted in order of either or both of distance and direction from the handheld computer (100). (See Specification, pages 8-10, ¶¶ [0030]-[0035]; Figs. 6-7). The method also includes transmitting a wireless message to one or more local area computing devices (200-212) having wireless communication capability within the specified distance, where the wireless message includes information in addition to information necessary to sort the list.

Independent claim 16 is directed to a local area wireless communication device (100) that has a housing, a processor supported by the housing, a memory coupled to the processor, a transmitter supported by the housing, and a display (114). (See Specification, pages 6-7, ¶¶ [0025]-[0027]). The processor instructs the display (114) to list other computing devices (200-212) located within a range of the transmitter, sorted in order of by one or both of the distance and direction from the wireless communication device (100). (See Specification, pages 8-10, ¶¶ [0030]-[0035]). The transmitter is configured to transmit a wireless message to one of the other local area computing devices selected from the list and the wireless message includes information in addition to information necessary to sort the list.

Independent claim 24 is directed to a user interface for a handheld computer (100). The user interface includes a display (114) for providing a list of indicators corresponding to a plurality of local area computing devices (200-212) with which communication is possible. (See Specification, page 8, ¶ [0030]). The list is sorted by one or both of distance and

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direction from the handheld computer (100) and the list is configured to allow a user to select one of the indicators so that a user can share information with the corresponding local area computing device (200-212). (See Specification, pages 8-10, ¶¶ [0030]-[0035]).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are (1) whether claims 1-5, 8-13, 15-21, and 23-29 may properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,246,376 ("Bork") in view of U.S. Patent No. 6,542,750 ("Hendrey"); and whether claims 6, 14, 22, 30, and 31 may properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over Bork in view of Hendrey, and further in view of U.S. Patent No. 6,389,290 ("Kikinis").

7. ARGUMENT

I. LEGAL STANDARDS

All claim rejections at issue in this appeal are made under 35 U.S.C. § 103(a)[1] The legal standards under 35 U.S.C. § 103(a) are well-settled.

Obviousness under 35 U.S.C. § 103(a) is a legal conclusion involving four factual inquiries:

(1)   the scope and content of the prior art;

(2)   the differences between the claims and the prior art;

(3)   the level of ordinary skill in the pertinent art; and

(4)   secondary considerations, if any, of non-obviousness.

Litton Systems, Inc. v. Honeywell, Inc., 87 F. 3d 1559, 1567, 39 U.S.P.Q. 2d 1321, 1325 (Fed. Cir. 196). See also Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office (PTO), the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). A prima facie

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[1]   "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made." 35 U.S.C. §103(a).

case of obviousness requires that the prior art reference or references teaches or suggests all of the claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988); In re Lalu, 747 F.2d 703,705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 U.S.P.Q. 657, 667 n.24 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 782 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). It is improper to combine references where the references teach away from their combination. See In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If the proposed combination of the references would change the principle of operation of the reference being modified, the teachings of the references are not sufficient to render the claims prima facie obvious. See In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). If proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Proceeding contrary to accepted wisdom is evidence of non-obviousness. See In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 685 (Fed. Cir. 1986).

As noted by the Federal Circuit, the "factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ.2d 1001 (Fed. Cir. 2001). Further, it "must be based on objective evidence of record." In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant's

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disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

II. REJECTION OF CLAIMS 1-5, 8-13, 15-21, AND 23-29 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER BORK IN VIEW OF HENDREY

In the final Office Action dated December 1, 2005, the Examiner rejected claims 1-5, 8-13, 15-21, and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Bork in view of Hendrey.

Claim 1 is in independent form and claims 2-5 depend from claim 1.

Claim 8 is in independent form and claims 9-13 and 15 depend from claim 8.

Claim 16 is in independent form and claims 27-21 and 23 depend from claim 16.

Claim 24 is in independent form and claims 25-29 depend from claim 24.

The Examiner's rejections of claims 1-5, 8-13, 15-21, and 23-29 should be reversed because the Examiner has failed to establish a prima facie case of obviousness with regard to claims 1-5, 8-13, 15-21, and 23-29. More specifically, for at least the reasons stated below, no proper combination of Bork and Hendrey teaches or suggests the subject matter of claims 1-5, 8-13, 15-21, and 23-29.

A. THE REJECTION OF CLAIMS 1-5, 8-13, 15-21, AND 23-29 IS IMPROPER BECAUSE THE CITED REFERENCES FAIL TO TEACH OR SUGGEST AT LEAST ONE LIMITATION IN EACH OF THE REJECTED CLAIMS

A prima facie case of obviousness requires that the prior art reference or references teaches or suggests all of the claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The combination of Bork and Hendrey fails to teach or suggest at least

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one limitation in each of the rejected claims. Accordingly, the Examiner has failed to establish a prima facie case of obviousness and the rejection of claims 1-5, 8-13, 15-21, and 23-29 should be reversed.

1. Claims 1-5

Independent claim 1 recites a combination including, among other elements, "listing each identifier on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer." The combination of Bork and Hendrey does not teach or suggest the limitation of "listing each identifier on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer" as included in the combination of elements of claim 1.

In the final Office Action dated December 1, 2005, the Examiner acknowledged that "Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance and selecting the identifier to initiate information sharing." Office Action at page 2. The Examiner further stated, however, that "Hendrey teaches a method and system for selectively connecting mobile users for communication based on the physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], Col. 1 lines 14-19 and Col. 10 lines 1-21)." Office Action at pages 2-3.

Referring to Hendrey, connections are initiated between two or more mobile telecommunications users based on predefined criteria. Col. 5, lines 21-25. For example, a user may elect to initiate a call with a maximum number of callees within a predefined maximum distance of the user. Col. 7, lines 9-12. Upon receiving the predefined criteria, the communications unit simply initiates connections with the users satisfying the predefined criteria. The user does not select callees from a list, but merely provides the predefined criteria, which is then used to identify callees with whom a connection is then automatically initiated.

The concept of supplying predefined criteria to identify callees with whom a connection is automatically made is not the invention claimed in independent claims 1, 8, 16,

and 24. In contrast, Applicants have conceived of a method and system for displaying a list of indicators for local area computing devices, sorted by distance and/or direction, from which a user may select one or more of the local area computing devices to communicate with.

While Hendrey may disclose "initiating a connection between two or more proximately located mobile telecommunications users based on predefined criteria," col. 5, lines 21-25, Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of distance and/or direction. Referring to the portions of Hendrey cited by the Examiner, Applicant submits that viewed as a whole, Hendrey at col. 9, line 54 – col. 10, line 21 teaches that a user initiates a matchmaking request, and that a separate matchmaker 107 creates a list of best matches using information that is not provided to the user for display. The matchmaking system simply initiates a connection after identifying a callee based on the information. With regard to Fig. 2 and item 222, Applicant submits that, viewed as a whole, Hendrey teaches that group members within a maximum distance are selected, but does not teach that members of a group list 220 are sorted in group list 220 based on distance values in distance entry 222. Thus, the combination of Bork and Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of distance and/or direction.

In the Advisory Action dated February 21, 2006, the Examiner further stated that

> Hendrey states that the 'aspects of the invention relate to methods and systems for automatically and/or selectively initiating communications among mobile users in a telecommunications system that has the ability to determine geographic location of mobile users.' (Col. 1 lines 15-19), with selectively being the key word. Fig. 2 of Hendrey shows the telecommunications unit (201) connected to the telecommunications infrastructure (210), with the telecommunication unit capable of initiating connections selective to distance information (Col. 3 lines 34-36). Hendrey teaches the caller can dynamically generate a list, determine how many users to list, selectively connect to other users based on distance and have access to the "matchmaker" functions including distance information. (Col. 12 lines 38-56 and Col. 18 lines 6-14).

Applicant submits that the statements made in the Advisory Action fail to alter the conclusion that the Examiner has failed to establish a prima facie case of obviousness. The Examiner referenced col. 1, lines 15-19 of Hendrey, which recites the field of the invention,

and col. 3, lines 34-36, which is a portion of the brief description of the figures. Applicant submits that the cited passages fail to teach or suggest a display having a list sorted by distance and/or direction. The Examiner further refers to col. 12, lines 38-56, and col. 18, lines 6-14 of Hendrey in stating that Hendrey "teaches the caller can dynamically generate a list, determine how many users to list, selectively connect to other users based on distance and have access to the 'matchmaker' functions including distance information." Applicant again submits, however, that viewed as a whole, Hendrey teaches only that a user provides predetermined criteria, with which a separate matchmaker may generate a list that is not displayed to the user, but which is used to simply initiate a wireless connection. As stated above, this is not the Applicant's invention. Accordingly, Applicant submits that the combination of Bork and Hendrey fails to teach or suggest "listing each identifier on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer," as included in the combination of elements of claim 1.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because the combination of Bork and Hendrey does not teach or suggest at least one limitation of independent claim 1. Accordingly, the rejection of independent claim 1, and corresponding dependent claims 2-5, should be reversed.

2.   Claims 8-13 and 15

Independent claim 8 recites a combination including, among other elements, "listing the one or more local area computing devices on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer." The combination of Bork and Hendrey does not teach or suggest the limitation of "listing the one or more local area computing devices on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer," as included in the combination of elements of claim 8.

In the final Office Action dated December 1, 2005, the Examiner acknowledged that "Bork differs from the claimed invention by not mentioning a listing of identifiers on a display that can be sorted by distance, selecting the identifier to initiate information and

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sharing and transmitting additional information." Office Action at pages 3-4. The Examiner further stated, however, that "Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], col. 1 lines 14-19 and Col. 10 lines 1-21)." Office Action at page 4.

As discussed in Section 7(II)(A)(1) with respect to claim 1, while Hendrey may disclose "initiating a connection between two or more proximately located mobile telecommunications users based on predefined criteria," col. 5, lines 21-25, Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction. Referring to the portions of Hendrey cited by the Examiner, Applicant submits that viewed as a whole, Hendrey at col. 9, line 54 – col. 10, line 21 teaches that a user initiates a matchmaking request, and that a separate matchmaker 107 creates a list of best matches using information that is not provided to the user for display. The matchmaking system simply initiates a connection after identifying a callee based on the information. With regard to Fig. 2 and item 222, Applicant submits that, viewed as a whole, Hendrey teaches that group members within a maximum distance are selected, but does not teach that members of a group list 220 are sorted in group list 220 based on distance values in distance entry 222. Thus, the combination of Bork and Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction.

In the Advisory Action, the Examiner presented no new arguments than those presented with respect to independent claim 1. Applicants therefore submit that, for at least the reasons presented in Section 7(II)(A)(1) with respect to claim 1, the Advisory Action fails to alter the conclusion that the Examiner has failed to establish a prima facie case of obviousness with respect to independent claim 8.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because the combination of Bork and Hendrey does not teach or suggest at least one limitation of independent claim 8. Accordingly, the rejection of independent claim 8, and corresponding dependent claims 9-13 and 15, should be reversed.

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3. Claims 16-21 and 23

Independent claim 16 recites a combination including, among other elements, "wherein the processor instructs the display to list a plurality of other computing devices located within a range of the transmitter, sorted in order of at least one of the distance and the direction from the wireless communication device." The combination of <u>Bork</u> and <u>Hendrey</u> does not teach or suggest the limitation of "wherein the processor instructs the display to list a plurality of other computing devices located within a range of the transmitter, sorted in order of at least one of the distance and the direction from the wireless communication device," as included in the combination of elements of claim 16.

In the final Office Action dated December 1, 2005, the Examiner acknowledged that "Bork differs from the claimed invention by not mentioning a listing of the identifiers on a display that can be sorted by distance and direction." The Examiner further stated, however, that "Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], col. 1 lines 14-19 and Col. 10 lines 1-21) <u>Hendrey</u> teaches a message with local information and a request for a match making with a closely located user. (Col. 9 lines 54-67) Office Action at page 4.

As discussed in Section 7(II)(A)(1) with respect to claim 1, while <u>Hendrey</u> may disclose "initiating a connection between two or more proximately located mobile telecommunications users based on predefined criteria," col. 5, lines 21-25, <u>Hendrey</u> does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction. Referring to the portions of <u>Hendrey</u> cited by the Examiner, Applicant submits that viewed as a whole, <u>Hendrey</u> at col. 9, line 54 – col. 10, line 21 teaches that a user initiates a matchmaking request, and that a separate matchmaker 107 creates a list of best matches using information that is not provided to the user for display. The matchmaking system simply initiates a connection after identifying a callee based on the information. With regard to Fig. 2 and item 222, Applicant submits that, viewed as a whole, <u>Hendrey</u> teaches that group members within a maximum distance are selected, but does not teach that members of a group list 220 are sorted in group list 220 based on distance values in

distance entry 222. Thus, the combination of Bork and Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction.

In the Advisory Action, the Examiner presented no new arguments than those presented with respect to independent claim 1. Applicants therefore submit that, for at least the reasons presented in Section 7(II)(A)(1) with respect to claim 1, the Advisory Action fails to alter the conclusion that the Examiner has failed to establish a prima facie case of obviousness with respect to independent claim 16.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because the combination of Bork and Hendrey does not teach or suggest at least one limitation of independent claim 16. Accordingly, the rejection of independent claim 16, and corresponding dependent claims 17-21 and 23, should be reversed.

4. Claims 24-29

Independent claim 24 recites a combination including, among other elements, "wherein the list is sorted by at least one of distance and direction from the handheld computer." The combination of Bork and Hendrey does not teach or suggest the limitation of "wherein the list is sorted by at least one of distance and direction from the handheld computer," as included in the combination of elements of claim 1.

In the final Office Action dated December 1, 2005, the Examiner acknowledged that "Bork differs from the claimed invention by not mentioning a listing of identifiers on a display that can be sorted by distance and direction." The Examiner further stated, however, that "Hendrey teaches a method and system for selectively connecting mobile users for communication based on physical proximity that includes a communication device (Fig. 2 [201]) with a proximity sorting system. (Fig. 2 [222], col. 1 lines 14-19 and Col. 10 lines 1-21)." Office Action at page 4.

As discussed in Section 7(II)(A)(1) with respect to claim 1, while Hendrey may disclose "initiating a connection between two or more proximately located mobile

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telecommunications users based on predefined criteria," col. 5, lines 21-25, Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction. Referring to the portions of Hendrey cited by the Examiner, Applicant submits that viewed as a whole, Hendrey at col. 9, line 54 – col. 10, line 21 teaches that a user initiates a matchmaking request, and that a separate matchmaker 107 creates a list of best matches using information that is not provided to the user for display. The matchmaking system simply initiates a connection after identifying a callee based on the information. With regard to Fig. 2 and item 222, Applicant submits that, viewed as a whole, Hendrey teaches that group members within a maximum distance are selected, but does not teach that members of a group list 220 are sorted in group list 220 based on distance values in distance entry 222. Thus, the combination of Bork and Hendrey does not teach or suggest listing identifiers on a display where the list is sorted in order of one or both of distance and direction.

In the Advisory Action, the Examiner presented no new arguments than those presented with respect to independent claim 1. Applicants therefore submit that, for at least the reasons presented in Section 7(II)(A)(1) with respect to claim 1, the Advisory Action fails to alter the conclusion that the Examiner has failed to establish a prima facie case of obviousness with respect to independent claim 24.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because the combination of Bork and Hendrey does not teach or suggest at least one limitation of independent claim 24. Accordingly, the rejection of independent claim 24, and corresponding dependent claims 25-29, should be reversed.

B.   THE REJECTION OF CLAIMS 1-5, 8-13, 15-21, AND 23-29 SHOULD BE REVERSED BECAUSE THERE IS NO SUGGESTION TO COMBINE THE TEACHINGS OF BORK AND HENDREY

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of these references. To satisfy this burden, the Examiner must show some objective teaching in the prior art or that knowledge generally

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available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992). When the . motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). The combination of references cannot change the principal of operation of the primary reference. In re Ratti, 270 F.2d 810 (C.C.P.A. 1959). In this case, the Examiner has not established that there would have been motivation or suggestion to combine the teachings of Bork and Hendrey. More specifically, there is no suggestion to combine the teachings of Bork and Hendrey because the proposed combination would change the principal of operation of Bork.

Referring to Bork, a system is disclosed for displaying, on a wireless device, the direction and distance to an object or person. Bork is directed to providing distance and direction information to a user. For example, Bork states at col. 7 lines 4-6 that "[t]he graphic display 114 is preferably capable of supporting a clear arrow indicating the target direction, as well as its estimated distance." Bork additionally states that alternative means of indicating distance and direction, such as audible or touch sensitive devices, may also be used. See col. 6, lines 39-44. Thus, Bork is clearly primarily concerned with providing specific distance and direction information to a user.

Referring to Hendrey, however, connections are initiated between two or more mobile telecommunications users based on predefined criteria without providing specific distance or direction information to the user. See Col. 5, lines 21-25. For example, a user may elect to initiate a call with a maximum number of callees within a predefined maximum distance of the user. See Col. 7, lines 9-12. Upon receiving the callee selection criteria, the communications unit simply initiates connections with the users satisfying the predefined criteria. The user does not select callees from a list, and the user is not provided with specific distance and/or direction information for any of the callees. The user merely provides the predefined criteria used to identify callees with whom a connection is then automatically initiated. This is a substantial change in operation from the system of Bork, where specific distance and direction information is provided to a user. Applying the concepts of Hendrey to the device in Bork would eliminate displaying the desired direction and distance information

in <u>Bork</u>. Therefore, because the proposed combination of <u>Bork</u> and <u>Hendrey</u> would change the principal of operation of <u>Bork</u>, there is no suggestion to combine the references.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion to combine the teachings of <u>Bork</u> and <u>Hendrey</u>. Accordingly, the rejection of claims 1-5, 8-13, 15-19, and 23-29 should be reversed.

III.   REJECTION OF CLAIMS 6, 14, 22, 30, AND 31 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER <u>BORK</u> IN VIEW OF <u>HENDREY</u> AND FURTHER IN VIEW OF <u>KIKINIS</u>

In the final Office Action dated December 1, 2005, the Examiner rejected claims 6, 14, 22, 30, and 31 under 35 U.S.C. as being unpatentable over <u>Bork</u> in view of <u>Hendrey</u>, and further in view of Kikinis. For the reasons stated below, the Examiner's rejection of claim 6, 14, 22, 30, and 31 should be reversed.

Claims 6, 14, 22, 30, and 31 variously depend from independent claims 1, 8, 16, and 24. As explained in Section II, the combination of <u>Bork</u> and <u>Hendrey</u> fails to render the subject matter of independent claims 1, 8, 16, and 24 prima facie obvious. As to <u>Kikinis</u>, it fails to make up for any of the deficiencies of the combination of <u>Bork</u> and <u>Hendrey</u> mentioned above. Because claims 6, 14, 22, 30, and 31 variously depend from independent claims 1, 8, 16, and 24, the rejection of claims 6, 14, 22, 30, and 31 should be reversed. <u>See</u> 35 U.S.C. § 112 ¶ 4.

8.   CONCLUSION

In view of the foregoing, Applicant submits that claims 1-5, 8-13, 15-21, and 23 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over <u>Bork</u> in view of <u>Hendrey</u>; and that claims 6, 14, 22, 30, and 31 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over <u>Bork</u> in view of <u>Hendrey</u>,

Respectfully submitted,

Date _____ 5/1/2006 _____   By _____

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CLAIMS APPENDIX

1.   A method of communicating between a handheld computer and other local

area computing devices having wireless communication capability, comprising the steps of:

    providing a handheld computer;

    identifying a plurality of other local area computing devices having wireless

communication capability;

    creating an identifier for one or more of the plurality of other local area

computing devices;

    listing each identifier on a display, wherein the list is sorted in order of at least

one of distance and direction from the handheld computer; and

    selecting one or more of the listed identifiers and sharing information with the

local area computing device corresponding to the chosen identifier.

2.   The method of claim 1, wherein the handheld computer is configured to

communicate with the plurality of other local area computing devices utilizing a

BLUETOOTH standard.

3.   The method of claim 1, wherein the handheld computer is configured to

communicate with the plurality of other local area computing devices utilizing an IEEE

802.11 standard.

4.   The method of claim 1, wherein the handheld computer is configured to

communicate with the plurality of other local wireless devices utilizing RF signals.

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5.   The method of claim 1, wherein the handheld computer is configured to communicate with the plurality of other local wireless devices utilizing infrared signals.

6.   The method of claim 1, wherein the information necessary to sort the list by at least one of distance and direction is provided by electronic pinging between the handheld computer and the plurality of other local area computing devices.

7.   (Cancelled).

8.   A method of sharing information between a handheld computer and a group of local area computing devices having wireless communication capability, comprising the steps of:

specifying a distance;

identifying one or more local area computing devices having wireless communication capability within the specified distance from the handheld computer;

listing the one or more local area computing devices on a display, wherein the list is sorted in order of at least one of distance and direction from the handheld computer; and

transmitting a wireless message to the one or more local area computing devices having wireless communication capability within the specified distance;

wherein the wireless message includes information in addition to information necessary to sort the list.

9.   The method of claim 8, wherein the display is a touch screen display.

10. The method of claim 8, wherein the wireless message is transmitted utilizing a BLUETOOTH standard.

11. The method of claim 8, wherein the wireless message is transmitted utilizing an IEEE 802.11 standard.

12. The method of claim 8, wherein the wireless message is transmitted utilizing RF signals.

13. The method of claim 8, wherein the wireless message is transmitted utilizing infrared signals.

14. The method of claim 8, wherein the information necessary to transmit the wireless message only within the specified distance is provided by electronic pinging between the handheld computer and the one or more local area computing devices.

15. The method of claim 8, further comprising the step of receiving a wireless message from the one or more local area computing devices having wireless communication capability within the specified distance.

16. A local area wireless communication device, comprising:

a housing;

a processor supported by the housing;

a memory coupled to the processor;

a transmitter supported by the housing; and

a display;

wherein the processor instructs the display to list a plurality of other

computing devices located within range of the transmitter, sorted in order of at least one of

the distance and the direction from the wireless communication device;

wherein the transmitter is configured to transmit a wireless message to one of

the other local area computing devices selected from the list; and

wherein the wireless message includes information in addition to information

necessary to sort the list.

17. The method of claim 16, wherein the display is a touch screen display.

18. The method of claim 16, wherein the local area wireless communication

device is configured to communicate with the plurality of other local area computing devices

utilizing a BLUETOOTH standard.

19. The method of claim 16, wherein the local area wireless communication

device is configured to communicate with the plurality of other local area computing devices

utilizing an IEEE 802.11 standard.

20. The method of claim 16, wherein the local area wireless communication

device is configured to communicate with the plurality of other local wireless devices

utilizing RF signals.

21. The method of claim 16, wherein the local area wireless communication

device is configured to communicate with the plurality of other local wireless devices

utilizing infrared signals.

22.   The method of claim 16, wherein the information necessary to sort the list by at least one of distance and direction is provided by electronic pinging between the local area wireless communication device and the plurality of other local area computing devices.

23.   The method of claim 16, wherein the wireless communication device is a handheld computer.

24.   A user interface for a handheld computer, comprising:

a display providing a list of indicators corresponding to a plurality of local area computing devices with which communication is possible;

wherein the list is sorted by at least one of distance and direction from the handheld computer;

and wherein the list is configured to allow a user to select one of the indicators so that the user can share information with the corresponding local area computing device.

25.   The user interface of claim 24, wherein the display is a touch screen.

26.   The user interface of claim 24, wherein the handheld computer is configured to communicate with the plurality of local area computing devices utilizing a BLUETOOTH standard.

27.   The user interface of claim 24, wherein the handheld computer is configured to communicate with the plurality of local area computing devices utilizing an IEEE 802.11 standard.

28.   The user interface of claim 24, wherein the handheld computer is configured to communicate with the plurality of local wireless devices utilizing RF signals.

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29.   The user interface of claim 24, wherein the handheld computer is configured to communicate with the plurality of local wireless devices utilizing infrared signals.

30.   The user interface of claim 24, wherein the information necessary to sort the list by distance is provided by electronic pinging between the handheld computer and the plurality of local area computing devices.

31.   The user interface of claim 24, wherein the information necessary to sort the list by at least one of distance and direction is provided by electronic pinging between the handheld computer and the plurality of other local area computing devices.

32.   (Cancelled).

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.

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